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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,378	12/12/2001	James Sheung Lau	CA920000074US1	2828

7590 10/05/2005

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EXAMINER	
ELMORE, JOHN E	

ART UNIT	PAPER NUMBER
2134	

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/015,378	LAU, JAMES SHEUNG	
	Examiner	Art Unit	
	John Elmore	2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 August 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-39* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22 and 25-39* is/are rejected.

7)☒ Claim(s) *23 and 24* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *11 March 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. In response to the previous office action, Applicant has amended claims 4, 5 and 31. Claims 1-39 have been examined.

Objections to Specification

2. In view of Applicant's amendment, the previous objections to the specification are withdrawn.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. **Claims 1-3, 6-13, 16-20, 29, 30 and 32-39 are rejected under 35 U.S.C. 102(b)** as being anticipated by Ginter (US 5,892,900).

Regarding claim 1, Ginter discloses a method comprising:

embedding in said computer readable content (VDE object 300, which is a container 302 holding content 304; col. 13, lines 50-67; col. 59, lines 8-15; col. 134, lines 11-14) instruction codes (processes comprising the VDE 100/PPE 650, including ROS 602 application, are embedded with content in a container; col. 134, line 67-col. 135, line 1; col. 134, lines 15-28; col. 135, lines 35-58; ROS operates as application running on top of operating system, allowing it to be packaged with content; col. 86, lines 58-61),

operable to direct a processor circuit (electronic appliance 600) to automatically establish a connection to a server (VDE administrator or clearinghouse) when said content is in use by said processor circuit, to transmit registration information to said server (ROS 602 automatically registers with clearinghouse/repository in order to receive container/object 300 and permissions, including keys, to use content; col. 160, lines 35-64; col. 168, line 1, through col. 169, line 67; col. 307, lines 24-30 and 57-67; col. 314, line 62-col. 315, line 25) and

operable to control further use of said content by said processor circuit in response to a key received from said server (content key decrypts content in object 300 for registered users; col. 136, lines 9-28; col. 199, lines 33-65; col. 223, lines 6-11).

Regarding claim 2, Ginter teaches all the limitations of claim 1, and further teaches storing said computer readable content and said embedded instruction codes on a portable memory medium (e.g. CD-ROM; col. 18, lines 6-21; col. 55, lines 24-31).

Regarding claim 3, Ginter teaches all the limitations of claim 1, and further teaches providing said computer readable content and said embedded instruction codes for use by a user computer (use by electronic appliance 600, which is a user computer; col. 60, line 8, through col. 61, line 34; col. 62, lines 31-37; col. 303, lines 41-50).

Regarding claim 6, this is equivalent to claim 3, with the further limitation that the computer readable content and instruction codes are provided to the user computer. Ginter teaches all the limitations of claim 3, and further teaches that the computer readable content and instruction codes are provided to the user computer (e.g. directly

via distribution over a communications network to user computer; col. 3, lines 22-25; col. 18, lines 6-10; or indirectly via CD-ROM; col. 18, lines 6-21; col. 55, lines 24-31).

Regarding claims 7-9, such claims are rejected on the same basis as provided for claim 6.

Regarding claim 10, such claim is rejected on the same basis as provided for claim 1.

Regarding claim 11, Ginter teaches all the limitations of claim 10, and further teaches that executing comprises causing said instruction codes to be executed when access is made to said content by said processor circuit (a process of the ROS 602 executes to enforce usage permissions PERC 808 as defined by the electronic contract 3200 when content is accessed by user; col. 26, lines 37-65; col. 61, lines 18, through col. 62, line 18; col. 155, lines 52-63; col. 169, lines 41-48; col. 176, lines 32-57; col. 273, lines 9-39).

Regarding claim 12, Ginter teaches all the limitations of claim 10, and further teaches that executing comprises producing a measure of use of said content by said processor circuit (metering method; col. 13, lines 46-49; col. 23, lines 37-44; col. 47, lines 64-66).

Regarding claim 13, Ginter teaches all the limitations of claim 12, and further teaches producing said measure of use of said content comprises determining a number of times said content is accessed by said processor circuit (metering method directs use counter; col. 150, line 44, through col. 153, line 28; col. 317, lines 43-46).

Regarding claim 16, Ginter teaches all the limitations of claim 12, and further teaches establishing said connection to said server when said measure of use exceeds a threshold value (recording content usage and reporting that usage to the server/clearinghouse; col. 18, lines 1-5; col. 36, lines 10-43; col. 134, lines 19-22; col. 168, lines 10-25; budget and metering events record content usage count and usage limit; col. 150, line 43-col. 151, line 31; col. 188, lines 29-38; metering event involved in usage monitoring triggers a reporting event, which directs the transmission of usage history to the clearinghouse, based on a condition being met, including the usage count exceeding the usage limit; col. 58, lines 23-61; col. 150, lines 43-52).

Regarding claim 17, Ginter teaches all the limitations of claim 16, and further teaches that establishing said connection comprises establishing an internet protocol connection with said server (it is inherent that a connection with a server over the internet (electronic superhighway 108) uses internet protocol; col. 168, lines 13-15; col. 307, lines 6-30 and 61-67).

Regarding claim 18, Ginter teaches all the limitations of claim 17, and further teaches comprising launching a browse session with a uniform resource locator pointing to a user registration page for permitting a user to enter registration information (col. 315, lines 26-29).

Regarding claim 19, Ginter teaches all the limitations of claim 17, and further teaches that controlling subsequent use of said content comprises enabling subsequent use of said content when said key is received from said server (content key decrypts

content in object 300; col. 21, lines 48-59; col. 199, lines 33-65; col. 217, lines 51-65; col. 223, lines 6-11).

Regarding claim 20, such claim is rejected on the same basis as claim 19 (it is inherent that the encrypted content is disabled from use where no key is received with which to decrypt the content).

Regarding claim 29, this is a computer-readable-medium version of the claimed method above (claim 1). Therefore, for reasons applied above, such a claim also is anticipated.

Regarding claim 30, this is a data-signal version of the claimed method above (claim 1). Therefore, for reasons applied above, such a claim also is anticipated.

Regarding claim 32, this is a system version of the claimed method above (claim 1). Therefore, for reasons applied above, such a claim also is anticipated.

Regarding claim 33, Ginter teaches all the limitations of claim 32, and further teaches that said receiver (I/O controller 660 of electronic appliance 600) includes a media reader (e.g. electronic appliance includes a CD-ROM reader; Fig. 8; col. 62, lines 51-67; col. 63, lines 13-16).

Regarding claim 34, Ginter teaches all the limitations of claim 32, and further teaches that said communications interface (communications controller 666 of electronic appliance 600) is operable to establish communications on a network (col. 63, lines 2-5).

Regarding claim 35, Ginter teaches all the limitations of claim 32, and further teaches that said processor circuit (CPU 654) is part of a personal computer (electronic appliance 600) (col. 60, lines 8-9 and 58-61; col. 62, lines 32-37).

Regarding claim 36-39, this is a system version of the claimed method above (claims 25-28). Therefore, for reasons applied above, such a claim also is anticipated.

2. **Claims 10, 12, 15, 20 and 21 are rejected under 35 U.S.C. 102(e)** as being anticipated by Stefik et al. (US 6,236,971), hereafter Stefik.

Regarding claim 10, Stefik discloses a method comprising:

executing instruction codes (playback platform/player/interpreter) embedded in said computer readable content (playback platform/player/interpreter embedded with content; col. 6, lines 46-50; col. 26, lines 24-28),

when said content is in use by a processor circuit (processor of computer system executing playback platform/interpreter and repository 201), to automatically establish a connection to a server (repository 201) to transmit registration information to said server (playback platform/player/interpreter automatically establishes a connection to repository 201 upon attempt by user to access content, whereby repository 201 receives registration information which is used to complete the transaction via repository 201 and credit server 301; col. 7, lines 52-64; col. 8, line 64-col. 9, line 6; col. 26, lines 14-37; col. 27, lines 20-28; col. 29, lines 20-49; col. 30, lines 15-16) and

to control subsequent use of said content by said processor circuit in response to a key (digital ticket) received from said server (col. 8, lines 1-7; col. 14, lines 65-67; col. 30, lines 64-67; col. 31, lines 16-24).

Regarding claim 12, Stefik teaches all the limitations of claim 10, and further teaches that executing comprises producing a measure of use of said content by said processor circuit (Table 1; col. 7, lines 32-42; col. 10, lines 28-38; col. 46, lines 14-15).

Regarding claim 15, Stefik teaches all the limitations of claim 12, and further teaches that producing said measure of use comprises determining document usage by function descriptive content in said computer readable content (metering of documents; Table 1; col. 6, lines 46-50; col. 47, lines 64-66).

Regarding claim 20, Stefik teaches all the limitations of claim 10, and further teaches that controlling subsequent use of said content comprises disabling further use of said content when no key is received from said server (content unusable without key; col. 31, lines 21-24).

Regarding claim 21, Stefik teaches all the limitations of claim 20, and further teaches deleting files produced by functional descriptive content in said computer readable content (digital work reproduced by playback platform/player/interpreter is deleted after usage rights to play are exhausted; col. 35, line 65, through col. 36, line 31).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. **Claims 4, 5, 25-28 and 31 are rejected under 35 U.S.C. 103(a)** as being unpatentable over Ginter.

Regarding claim 4, Ginter teaches all the limitations of claim 1, but Ginter does not explicitly explain that embedding composes embedding a self-executing applet in said computer readable content.

However, Ginter teaches that the instruction codes (ROS 602) operate on the user computer (electronic appliance 600) in order to securely enforce the usage permissions (electronic contract 3200) accepted at registration and that such enforcement of the contract is self-executing (col. 19, lines 34-45; col. 25, lines 43-57; col. 26, lines 37-65; col. 60, lines 15-16; col. 63, lines 28-44; col. 176, lines 32-57; col. 273, lines 9-39). Further, as Microsoft Computer Dictionary defines an applet as "a program that can be downloaded over the Internet and executed on the recipient's machine," it follows that one of ordinary skill in the art would recognize that the ROS 602 as an applet where the ROS 602 is downloaded to the recipient machine and executed. Therefore, the Examiner takes official notice that it would be obvious that embedding composes embedding a self-executing applet in said computer readable

content for the motivation of securely enforcing usage permissions of content provided to the user.

Regarding claim 5, such claim is rejected on the same basis as provided for claim 4.

Regarding claim 25, Ginter teaches all the limitations of claim 1, but Ginter does not explicitly explain that the key is operable to cooperate with said user computer to deactivate execution of instruction codes embedded in said computer readable content at said user computer.

However, Ginter teaches that the instruction codes (ROS 602 and other processes that comprise the PPE 650) embedded in said computer readable content (containter/object 300) at said user computer (electronic appliance 600) contain "false" executable code that disables the execution of the PPE 650, thereby preventing access to the content, for the purpose of protecting the content against unauthorized use (col. 238, lines 50-54; col. 239, lines 2-4). One of ordinary skill in the art would recognize that normal operation of the instruction codes would require that the false executable code be deactivated via the key received upon proper registration by a user in order to prevent the PPE 650 from being disabled. Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made that the key is operable to cooperate with said user computer to deactivate execution of instruction codes embedded in said computer readable content at said user computer for the motivation of protecting the content against unauthorized use.

Regarding claim 26, Ginter teaches all the limitations of claim 25, and further teaches comprising launching a browse session with a uniform resource locator pointing to a user registration page for permitting a user to enter registration information (col. 315, lines 26-29). Therefore, for reasons applied above, such a claim also would have been obvious.

Regarding claim 27, Ginter teaches all the limitations of claim 26, and further teaches validating said registration information (col. 166, lines 28-49; col. 169, lines 41-57; col. 184, line 32, through col. 185, line 4). Therefore, for reasons applied above, such a claim also would have been obvious.

Regarding claim 28, Ginter teaches all the limitations of claim 26, and further teaches executing the act of transmitting when said registration information is successfully validated (col. 169, lines 57-64; col. 185, line 64, through col. 186, line 16). Therefore, for reasons applied above, such a claim also would have been obvious.

Regarding claim 31, this is a data-signal version of the claimed method above (claim 4). Therefore, for reasons applied above, such a claim also would have been obvious.

5. **Claims 14, 15 and 22 are rejected under 35 U.S.C. 103(a)** as being unpatentable over Stefik.

Regarding claim 14, Stefik teaches all the limitations of claim 12, and further teaches producing said measure of use comprises determining usage of functional descriptive content in said computer readable content (metered use, Table 1; col. 6,

lines 46-50; col. 47, lines 64-66). But Stefik does not explicitly explain that usage is determined by memory usage. However, the Examiner takes official notice that it would be obvious to one of ordinary skill in the art at the time of the invention that usage is determined by memory usage for the motivation that memory usage is a simple and effective means for counting when a digital work is in use, particularly where use is permitted at a metered rate, noting that the mere presence of a copy of a work on a hard drive, for instance, would not readily indicate the time duration the work has been used while monitoring the memory usage of an interpreter would.

Regarding claim 22, Stefik teaches all the limitations of claim 22, but does not explain warning a user of said processor circuit that files are about to be deleted. However, Stefik teaches that the processor circuit interacts with the user through a graphical user interface (col. 16, lines 33-42). And it is widely known in the art that computers running graphical user interfaces will display a warning to the user that files are about to be deleted. Therefore, the Examiner takes official notice that it would be obvious to one of ordinary skill in the art to warn a user of said processor circuit that files are about to be deleted for the motivation of informing a user about data operations that may impact a user's decision-making.

Allowable Subject Matter

6. **Claims 23 and 24 are objected to** as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

Regarding claims 23 and 24, the closest prior art, Ginter, does not explain maintaining a count of the number of times a warning about deleting files is presented to the user. While Ginter teaches in general that warning messages are provided to the user, Ginter makes no suggestion that these warning messages pertain to the deletion of files or that these warnings should be counted. Given the nontrivial effort involved in modifying Ginter to provide for the monitoring and counting of such warnings, it would not seem obvious to one of ordinary skill in the art at the time the invention was made to provide for maintaining a count of the number of times a warning about deleting files is presented to the user.

Response to Amendment

3. Applicant's arguments filed 17 August 2005 have been fully considered but they are not persuasive.

Regarding Applicant's argument that Applicant's claimed method provides "a means for embedding digital information" which is "in sharp contrast to the method of Ginter" (Remarks, page 14), it is noted that in one embodiment Ginter teaches the installation of a virtual distribution environment (VDE) on each physical device to which content is distributed as a prior and separate step to the installation of the contents. However, Ginter teaches in another embodiment that the VDE is embedded along with the contents, stating that "VDE 100 containers can also be stored with all required

control structures and content together" (col. 134, line 67-col. 135, line 1), the control structures including "computer software and/or methods used to manipulate, record, and/or otherwise control use of said content" (col. 134, lines 19-21) (see also col. 57, lines 66-67; col. 134, lines 15-28; col. 135, lines 35-58). Moreover, Ginter teaches that the rights operating system (ROS) of the VDE, which is used to control the use of content, is constructed by the content creator along with the content (col. 91, lines 26-42) and operates as an application running on top of the user device's operating system (so that the application may accompany the content and be installed along with the content as opposed to requiring that the operating system first be modified) (col. 86, lines 58-61). Hence, Ginter teaches that the software used to record and control the use of the content is embedded along with the content itself.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Elmore whose telephone number is 571-272-4224. The examiner can normally be reached on M 10-8, T-Th 9-7.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Morse can be reached on 571-272-3838. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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